



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Am

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,753	08/06/2001	Wassim Fayed	210731	3571

23460 7590 06/16/2005

LEYDIG VOIT & MAYER, LTD
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6780

EXAMINER

SCHUBERT, KEVIN R

ART UNIT PAPER NUMBER

2137

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,753

Applicant(s)

FAYED ET AL.

Examiner

Kevin Schubert

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-29 have been considered.

Election/Restrictions

5 Restriction to one of the following inventions is proper under 35 U.S.C. 121:

 I. Claims 1-24 are directed to a method for installing a computer software program using a transponder, classified in 713/184 (Electrical Computers and Digital Processing Systems: System Access Control Based on User Identification by Cryptography: PIN/Password Generator Device).

 II. Claims 25-28 are directed to a method for attaching a transponder to a computer
10 software program, classified in 713/200 (Electrical Computers and Digital Processing Systems: Security).

 III. Claim 29 is directed to a method for authenticating a credit card using a transponder, classified in 713/202 (Electrical Computers and Digital Processing Systems: Security: Password).

 The inventions are distinct each from each other because:

15 Inventions I,II, and III are related as subcombinations.

 Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case invention I has separate utility because it is used as a method for installation of a computer software product. See MPEP 806.05.

20 Inventions II and III are related as subcombinations disclosed as usable together in single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case invention III has separate utility because it is used as a method of determining authenticity of a credit card. See MPEP 806.05.

 Inventions I and III are related as subcombinations disclosed as usable together in a single
25 combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case invention I has separate utility because it is used as a method for installation of a computer software product. See MPEP 806.05.

Art Unit: 2137

Because the inventions are distinct for the reasons given and have acquired a separate status in the art, restriction for examination purposes is proper. A complete response to this requirement must include an election of the invention to be examined even if the requirement is traversed (37 CFR 1.143).

5 This application also contains claims directed to four patentably distinct species of the invention of Group 1. The species differ based on two characteristics: (1) whether a transponder is attached to the surface of the computer readable medium or whether the transponder is embedded within the computer readable medium; and (2) whether the reader is a component of an optical disk drive system or whether the reader is integrated with a handheld input device. The invention of group 1 is therefore directed to
10 four patentable distinct species:

 Within Group I the following species exist:

- a. where the transponder is attached to the surface of the computer readable medium and the reader is a component of an optical disk drive (claims 18 and 21);
- b. where the transponder is attached to the surface of the computer readable medium and
15 the reader is integrated with a handheld input device (claims 18 and 22);
- c. where the transponder is embedded within the computer-readable medium and the reader is a component of an optical disk drive (claims 19 and 21);
- d. where the transponder is embedded within the computer-readable medium and the
20 reader is integrated with a handheld input device (claims 19 and 22).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any
25 claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Art Unit: 2137

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection

5 under 35 U.S.C. 103(a) of the other invention.

Conclusion

A shortened statutory period for response to this action is set to expire one month from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the

10 application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

15 Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

20 Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER**

25 ***